

REMARKS

The present Amendment responds to the Office Action dated September 19, 2006 having a shortened statutory period for response set to expire December 19, 2006. Filed concurrently herewith is a request for a two (2) month extension of time to respond, making the present Amendment due by February 19, 2007, a federal holiday, such that the present Amendment is timely if submitted on Tuesday, February 20, 2007.

In the Office Action claims 1-12 are pending. The Examiner takes the position that the application claims at least eight (8) separate inventions and requested Applicants to elect an invention to prosecute. Applicants affirm the election of Groups I and VI, which was made during a telephone conversation between the Examiner and Mr. Thomas Hamilton on August 29, 2006. Accordingly, claim 1 has been amended so that the formula I includes a 1,2 diazole attached thereto at the 4-position. Also, claims 2, 9 and 10 have been cancelled. Applicants reserve the right to file one or more continuing applications claiming the subject matter of these cancelled claims. In addition, Applicants submit herewith a Supplemental Information Disclosure Statement as suggested by the Examiner. The Supplemental IDS provides full and complete copies of the three (3) references cited.

Turning to the Office Action, Applicants note with appreciation that the Examiner's search of the prior art has "yielded no references that anticipate or adequately suggest the instant compounds" and further that "all claims are free of the art." (OA, p. 6). However, the Examiner has raised a rejection of claims 11 and 12 under 35 U.S.C. 112, first paragraph, taking the position that the claims fail to "comply with the written description requirement." (OA, p. 5). More particularly, the Examiner appears to object to the terms "microorganisms" and "preventing" appearing in the claims. With respect to "microorganisms", the Examiner takes the position that "[t]he specification only provides firm support for the compounds of claim 1 to control fungal inventions in plants" and that "the compounds have only been tested against fungi, and not bacteria, amoebae, etc. that would fall under the genus of microorganism." (OA, p. 5). While Applicants do not concede the Examiner's position in this regard, the Examiner will note that claims 11 and 12 have been amended to replace the occurrence of "microorganisms" to "fungi". Applicants respectfully submit that this amendment addresses the Examiner's concerns.

Now, with respect to the occurrence of "preventing" in the claims, the Examiner argues "[t]he examples cite that infestation is prevented virtually completely (0-5%), but there is no showing that full prevention can be accomplished by application of the compounds, i.e. 0% infestation." (OA, p. 5). The Examiner uses this argument to support that claims 11 and 12 "fail to meet the written

description requirement of 35 U.S.C. 112, first paragraph, as a person of skill in the art would not conclude that the Applicant was not in possession of the full invention as claimed.” (OA, p. 5). Applicants respectfully disagree with the Examiner’s position.

Section 2111.01 of the MPEP provides, in part:

During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) (The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation >in light of the specification<.). This means that the words of the claim must be given their plain meaning unless >>the plain meaning is inconsistent with< the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004)

(MPEP § 2111.01, p. 2100-38). Applicants respectfully submit that the Examiner has not given the claims their broadest reasonable interpretation in light of the specification. Furthermore, the Examiner significantly narrows the meaning of “prevent” to mean “full prevention” or “0% infestation”. In doing so, the Examiner has unfairly imported into a claim limitations into both claims 11 and 12 that are not part of the claim. Neither claim 11 nor claim 12 include the recitation of “full prevention” or “0% infestation”. Claims 11 and 12 recite, in part:

11. A composition for controlling fungi and preventing attack and infestation of plants therewith ...
12. A method of controlling or preventing infestation of cultivated plants by phytopathogenic fungi.....

The American Heritage Dictionary of the English Language, edited by William Morris, Boston: Houghton Mifflin Company, 1969, define the words “prevent”, “attack”, and “infest” as follows:

Prevent (definitions 1. and 2.)

1. To keep from happening, as by some prior action; avert; thwart.
2. To keep (someone) from doing something; hinder; impeded.

Attack (definitions 1. and 4.)

1. To set upon with violent force; begin hostilities against or conflict with.
4. To begin to affect harmfully

Infest (definition 1.)

1. To inhabit or overrun in large numbers so as to be harmful or unpleasant.

See, American Heritage Dictionary, pp. 1038, 84, and 673 attached hereto.

In reviewing the plain meaning of the above three terms, Applicants submit that "prevent" does not mean "0% infestation", but more broadly means to avert, thwart, or hinder violent force, harmful affects, or the condition of being inhabited or overrun by large numbers. The plain meaning of the words is consistent with their use in Applicants' specification. Throughout the specification, Applicants state that compositions containing a compound of formula I prevent infestation of plants by phytopathogenic microorganisms. See, for example, pp. 1 and 81. Applicants have provided multiple examples of preventing attack and infestation of plants on pages 88-92 of the specification. In each of these examples, the plants were inoculated with a selected disease after being treated with a composition containing a compound of formula I. In every example, the composition thwarted the harmful affect of the disease or kept the plant from being overrun by the disease. Indeed, the plant did not succumb to the disease even upon direct exposure to the disease.

Applicants respectfully submit that neither the ordinary or customary meaning of the terms "prevent", "attack", or "infestation" or the meaning of the terms in the context of the specification require "full prevention" or "0% infestation". This meaning appointed by the Examiner is not expressly stated in the claim or in the context specification and, as such, improperly limits their meaning. Accordingly, Applicants submit the specification reasonably conveys to those skilled in the art that they were in possession of the invention as claimed in claims 11 and 12 as of the date of invention. The scope of protection sought in claims 11 and 12, when the terms are given their ordinary and customary meaning or their broadest reasonable interpretation in light of the specification, is supported and justified by the specification. As such, Applicants respectfully request that the Examiner withdrawn the claim objection of claims 11 and 12 under § 112, first paragraph.

Finally, the Examiner will note that new claim 13 has been added to the specification and that no new matter is believed to be added to the application by the addition of this claim. Claim 13 finds support, for example, on page 7 of Applicants' specification.

Based upon the foregoing then, Applicants submit that the pending claims are in condition for allowance and the Examiner is courteously solicited to pass this application on to allowance. No other fees are believed to be payable at this time. However, the Commissioner is authorized to debit any applicable fees from the deposit account of the undersigned, no 50-1676 in the name of Syngenta Crop Protection, Inc.

Respectfully submitted,

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